

## REMARKS

This Rule 116 Amendment is responsive to the Final Office Action dated June 23, 2009. Applicant respectfully requests reconsideration of the rejections in view of the remarks below. Applicant respectfully believes that this Rule 116 Amendment is appropriate because, should the Examiner maintain her rejections, the Applicant will have a better understanding of the issues should an appeal be necessary.

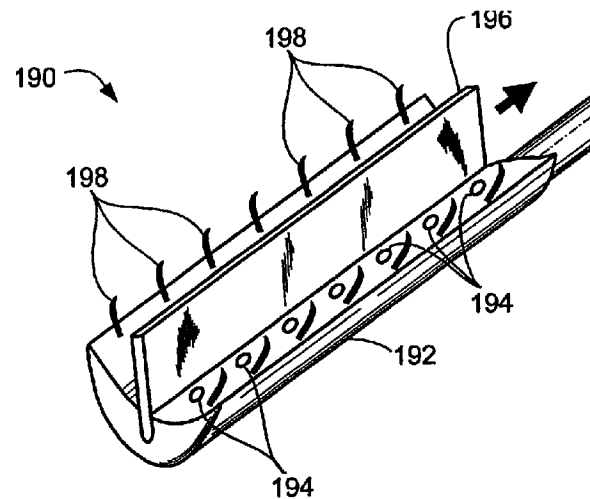
In the application claims 29 - 34 are pending and each claim stands rejected under the combination of Deem, U.S. Patent No. 6,558,400 with Adams et al., U.S. Patent Publication No. 2003/0132267 ("Adams").

### Claim 29

Claim 29 is directed to a gastroplasty device that includes first and second tissue acquisition members, each acquisition member including a tissue receiving cavity, and a stapler. The Office Action states: "Deem discloses the claimed device except for the first tissue acquisition member being pivotable about the longitudinal axis." The Office Action then states that it would have been obvious "to provide a pivotable first tissue acquisition member, as taught by Adams et al., to Deem in order to accommodate variable-sized tissue selections and since it was known in the art that pivotable tissue acquisition members facilitate grasping and apposition of tissue to ensure engagement of tissue." [Office Action, p. 3].

In the "Response To Arguments" section of the Final Office Action, the examiner states that "the benefit having the tissue acquisition member of Deem being pivotable along a longitudinal hinge, as taught by Adams, would be allowing the member to accommodate variably-sized tissue sections." [O.A., p. 4]. This is very unclear to the Applicant. The "size" of the tissue section can be length (in the axial direction) or width (in the radial direction). In the axial direction, the size is governed by the number and

spacing of the vacuum ports, and would be unaffected by having pivoting tissue acquisition members. In the radial direction, the "width" of the tissue section is controlled by the location of the staples with reference to the vacuum ports, with are also fixed whether the tissue acquisition members are pivoting or non-pivoting. Deems' device shown right would not obtain a different **size** tissue section if the stapler of Adams were somehow incorporated into Deem's device as contended



by the Office Action. The Office Action therefore has yet to explain any benefit to adding Adams' stapler to Deems' tissue acquisition device. If for no other reason than to establish exactly what the examiner's position is with regard to the proposed combination of Deem and Adams, it is respectfully requested that the final Office Action be withdrawn and a non-final Office Action be issued stating exactly what the examiner's position is with respect to this combination, along with any evidence of record that the Examiner intends to rely upon.

The Office Action also makes a statement that Adams, and specifically the seventh embodiment, teaches first and second tissue **acquisition members**. However, the cited paragraph 125 relied upon by the Office Action merely states that the stapler of Figures 21-25 has a "tissue receiving position." This would appear to be the "open" configuration where tissue can be received between the stapler and anvil. However, there is nothing that can "acquire" tissue and therefore the Office Action's statement that Adams teaches "tissue acquisition members" is incorrect.

Applicant would further assert that stapler 17 and anvil 10 cannot satisfy Claim 29's tissue acquisition members. First, stapler 17 and anvil 10 do not "acquire" tissue,

and there is no disclosure in Adams to demonstrate that these structures acquire tissue. Moreover, the stapler 17 cannot be a tissue acquisition member as claimed because the claimed tissue acquisition member has a stapler "disposed on the first tissue acquisition member" and Adams does not teach a stapler disposed on the stapler 17. Similarly, there is no stapler disposed on the anvil 10 of Adams. Thus, neither the stapler 17 nor anvil 10 of Adams can satisfy the claimed "first and second acquisition members" of Claim 29 and the rejection of Claim 29 is properly withdrawn. If the rejection is maintained, Applicant respectfully requests that the final office action be withdrawn and a non-final office action be entered explaining how the anvil 10 and stapler 17 of Adams satisfy the claimed first and second tissue acquisition members, including how they "acquire" tissue and how they have "staplers" disposed thereon.

Neither Adams nor Deem teach tissue acquisition members "including a tissue receiving cavity sized to receive a fold of stomach tissue." The Office Action does not cite to any structure that it contends satisfies this structural limitation, so Applicant finds it problematic to guess as to what the Office Action is referring when it contends that Deem teaches this claim limitation. Certainly there is no "cavity" in the cartridge assemblies **170** and **190** relied upon by the Office Action that would meet this claim limitation. In the assembly 170 shown in Figure 9A, there is no structure that would satisfy the "first and second acquisition members" and even if there were, there are no "cavities" that are part of any tissue acquisition members where the cavities are sized to receive a fold of stomach tissue. Thus, this is yet a third reason for withdrawing the final office action, if for no other reason than to explain the position of the previous office action and detail the exact structure and teaching of the prior art that the examiner is relying on. Because the final office action did not cite to any structures in its rejection but merely concluded that the missing claim elements were present, Applicant would be faced with guessing in an appeal as to what the examiner was referring. This is not only unfair to the Applicant, but fails to satisfy the Office's burden of establishing a *prima*

*facie* case of obviousness with evidence of record as to the presence of the claimed subject matter.

Moreover, as stated in its earlier response the use of a staple in both the left and right halves of the Deem apparatus shown above strongly teach away from having pivotable halves since it would serve no purpose here. Employing Adams' stapling mechanism would be incompatible with Deem's tissue acquisition since there is no teaching in either reference that would allow Deem's longitudinal tissue acquisition with Adams' circumferential stapling. Since the Office Action's rejection requires the circumferential stapling of Adams, then it is incumbent upon the Office Action to explain how Deem must be re-engineered to acquire tissue because there is nothing on the face of either references that suggest how Deem to could be reconfigured to work with Adams' circumferential stapler. Because the rejection unduly relies on the Applicant's teachings to formulate the proposed combination of Deem and Adams, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the claims must be reconsidered in light of what the prior art references **actually suggest** to one of ordinary skill in the art without the benefit of the Applicant's present teaching.

The Office Action rejected Claim 35 without even attempting to show where the features of Claim 35 are taught or suggested in the prior art. For example, Claim 35 includes the feature whereby the first and second tissue receiving cavities are disposed between the stapler/anvil and the longitudinal hinge, and a septum projecting radially outward from the longitudinal hinge. The Office Action is wholly silent on these claim limitations, so Applicant cannot discern whether the limitations were deemed to be taught by the prior art but not discussed, or not considered by the Office Action. Either case suggests that a *prima facie* case of obviousness has not been established, and Applicant respectfully requests that the final office action be withdrawn and an explanation be

provided, supported by evidence of record, showing either that a *prima facie* case of obviousness is present or the claims passed to allowance.

If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is kindly invited to contact the undersigned at the number below.

The Commissioner is authorized to charge any deficiencies or fees in connection with this preliminary amendment to Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

By: /michael j. moffatt/  
Michael J. Moffatt  
Registration No. 39,304

MJM:spc  
Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Telephone: (310) 824-5555  
Facsimile: (310) 824-9696  
Customer No. 24201  
358725.1